

## REMARKS/ARGUMENTS

Claims 1, 3, 5-16, 18, and 20-28 remain in the application. Claims 1 and 16 have been amended. Claims 4 and 19 have been canceled. Reconsideration of this application, as amended, is respectfully requested.

Claims 1 and 16 have been amended to specify that the at least one enzyme that be incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode, or the electrical contact associated with the working electrode comprises a dehydrogenase enzyme. Support for this amendment can be found at page 15, lines 3-5 of the specification, at page 17, lines 9-12 of the specification, and in claims 4 and 19, as originally filed. Claims 1 and 16 have been further amended to specify that at least one enzyme and at least one mediator can be incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode, or the electrical contact associated with the working electrode. Support for this amendment can be found in TABLE 1, page 12 of the specification (Biosensor V).

Further support for these changes finds authority in In re Wertheim, 191 USPQ 90 (CCPA) 1976) at 97, wherein it is stated:

.....That what appellants claim as patentable to them is less than what they describe as their invention is not conclusive if their specification also reasonably describes that which they do claim. Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable. As we said in a different context in In re Saunders, 58 CCPA 1316, 1327, 44F F. 2d 599, 607, 170 USPQ 213, 220 (1971):

To rule otherwise would let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed. Cf. In re Ruff,

45 CCPA 1037, 1049, 256 F. 2d 590, 597, 188 USPQ 340, 347 (1958). Since the patent law provides for the amendment during prosecution of *claims*, as well as the specification supporting claims 35 USC 132, it is clear that the reference to "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention" in the second paragraph of 35 USC 112 does not prohibit the applicant from changing what he "regards as the invention" (i.e., the subject matter on which he seeks patent protection) during the pendency of his application.....

Claims 1, 3-5, 8, and 10 stand rejected under 35 U. S. C. §102 (b) as being anticipated by Gilmartin (U. S. Patent No. 5,795,453). This rejection is respectfully traversed for the following reasons.

Gilmartin, U. S. Patent No. 5,795,453 (hereinafter "Gilmartin"), was described on page 13-14 of the Amendment and Response under 37 CFR 1.116 filed 13 June 2005.

Gilmartin fails to disclose the use of a dehydrogenase enzyme as a suitable enzyme for any aspect of the electrode assembly described therein. For this reason, it is submitted that Gilmartin does not anticipate claims 1, 3, 5, 8, and 10 of this application.

Claims 1, 3-16, and 18-28 were rejected under 35 U. S. C. §102 (b) as being anticipated by Feldman et al. (U. S. Patent No. 6,299,757). This rejection is respectfully traversed for the following reasons.

Feldman et al., U. S. Patent No. 6,299,757 (hereinafter "Feldman et al."), was described on page 15 of the AMENDMENT AND RESPONSE filed 13 December 2004.

The claims of the present application recite that at least one enzyme, i.e., a dehydrogenase enzyme, or at least one enzyme, i.e., a dehydrogenase enzyme, and at least one mediator be incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode, or the electrical contact associated with the working electrode. According to the claims of the present application, the enzyme, i.e., a dehydrogenase

enzyme, either need not be mixed with the mediator or can be mixed with the mediator to prepare the substance that is incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode, or the electrical contact associated with the working electrode. TABLE 1 on page 12 of the specification discloses biosensors, i.e., Biosensor III and Biosensor IV, in which an enzyme need not be mixed with a mediator for use in the conductive track or the electrical contact of a biosensor. TABLE 1 on page 12 of the specification further discloses a biosensor, i.e., Biosensor V, in which an enzyme can be mixed with a mediator for use in the conductive track or the electrical contact of a biosensor. Feldman et al. does not disclose the use of an enzyme in a conductive track or in an electrical contact of a biosensor.

For the foregoing reasons, which are disclosed in the specification, Feldman et al. does not anticipate claims 1, 3, 5-16, 18, and 20-28 of this application.

Claims 1, 3, 4, 10, 12, 13, and 15 were rejected under 35 U. S. C. §102 (b) as being anticipated by Hughes et al. (U. S. Patent No. 6,129,823). This rejection is respectfully traversed for the following reasons.

Hughes et al., U. S. Patent No. 6,129,823 (hereinafter "Hughes et al."), was described on page 15 of the AMENDMENT AND RESPONSE filed 13 December 2004.

Hughes et al. does not disclose or suggest the use of a dehydrogenase enzyme as the particular enzyme for use in the electrode strip described therein. Accordingly, Hughes et al. does not anticipate claims 1, 3, 10, 12, 13, and 15 of this application.

Claims 1, 3-16, and 18-28 were rejected under 35 U. S. C. § 103 (a) as being unpatentable over Feldman et al. in view of Gilmartin. This rejection is respectfully traversed for the following reasons.

As stated previously, according to the claims of the present application, the enzyme, i.e., a dehydrogenase enzyme, either need not be mixed with the mediator or can be mixed with the mediator to prepare the substance that is incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working

electrode, or the electrical contact associated with the working electrode. As stated previously, TABLE 1 on page 12 of the specification discloses biosensors, i.e., Biosensor III and Biosensor IV, in which an enzyme need not be mixed with a mediator for use in the conductive track or the electrical contact of a biosensor. TABLE 1 on page 12 of the specification further discloses a biosensor, i.e., Biosensor V, in which an enzyme can be mixed with a mediator for use in the conductive track or the electrical contact of a biosensor. Feldman et al. does not disclose the use of an enzyme in a conductive track or in an electrical contact of a biosensor.

Feldman et al. discloses the glucose dehydrogenase enzyme, which is not disclosed in Gilmartin. Although, as stated previously, Gilmartin discloses the use of an enzyme and a mediator in the conductive track leading from the working electrode to the electrical contact associated with the working electrode, Gilmartin does not disclose that the enzyme can be a dehydrogenase enzyme. The dehydrogenase enzyme recited in the claims of this application is significantly different from the oxidase enzyme recited in Gilmartin because the oxidase enzyme generates hydrogen peroxide, which reacts with the electron transfer agent. The dehydrogenase enzyme does not generate hydrogen peroxide. Accordingly, Gilmartin requires an enzyme for which a dehydrogenase enzyme is not a suitable substitute.

In effect, the rejection is based on a piecemeal reconstruction of the prior art, which is impermissible, because it is impermissible within the framework of 35 U. S. C. § 103 to pick and choose from any one reference only so much of it as will support a given position (i.e., the conductive track in Gilmartin), to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art (i.e., the oxidase enzyme in the conductive track in Gilmartin). Thus, so long as the claims of this application require at least one enzyme to be a dehydrogenase enzyme, the combination of Feldman et al. and Gilmartin fails to render claims 1, 3, 5-16, 18, and 20-28 obvious to one of ordinary skill in the art.

In view of the differences between the enzyme in the conductive track described in Gilmartin and the conductive track recited in claims 1 and 16 of this application, as amended, and the claims depending from claims 1 (i.e., claims 3 and 5-16) and 16 (i.e., claims 18 and 20-28) of this application, as

amended, it is submitted that the combination of Feldman et al. and Gilmartin fails to render claims 1, 3, 5-16, 18, and 20-28 obvious to one of ordinary skill in the art.

Claims 1, 3, 4, 10, 12, 13, and 15 stand rejected under 35 U. S. C. § 103 (a) as being unpatentable over Hughes in view of Gilmartin. This rejection is respectfully traversed for the following reasons.

Hughes et al., U. S. Patent No. 6,129,823 (hereinafter "Hughes et al."), was described on page 15 of the AMENDMENT AND RESPONSE filed 13 December 2004.

Hughes et al. et al. does not disclose or suggest that at least one enzyme, i.e., a dehydrogenase enzyme, or at least one enzyme, i.e., a dehydrogenase enzyme, and at least one mediator, is incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode or the electrical contact associated with the working electrode. In Hughes et al., the reagents are deposited over the electrodes only.

The claims of the present application describe a biosensor that specifies that at least one enzyme, i.e., a dehydrogenase enzyme, or at least one enzyme, i.e., a dehydrogenase enzyme, and at least one mediator be incorporated in at least one of the first conductive track leading from the working electrode to the electrical contact associated with the working electrode, or the electrical contact associated with the working electrode. As stated previously, TABLE 1 on page 12 of the specification discloses biosensors, i.e., Biosensor III and Biosensor IV, in which an enzyme need not be mixed with a mediator for use in the conductive track or the electrical contact of a biosensor. TABLE 1 on page 12 of the specification further discloses a biosensor, i.e., Biosensor V, in which an enzyme can be mixed with a mediator for use in the conductive track or the electrical contact of a biosensor.

Although, as stated previously, Gilmartin discloses the use of an enzyme and a mediator in the conductive track leading from the working electrode to the electrical contact associated with the working electrode, Gilmartin does not disclose that the enzyme can be a dehydrogenase enzyme.

The dehydrogenase enzyme recited in the claims of this application is significantly different from the oxidase enzyme recited in Gilmartin because the oxidase enzyme generates hydrogen peroxide, which reacts with the electron transfer agent. The dehydrogenase enzyme does not generate hydrogen peroxide. Accordingly, Gilmartin requires an enzyme for which a dehydrogenase enzyme is not a suitable substitute.

In effect, the rejection is based on a piecemeal reconstruction of the prior art, which is impermissible, because it is impermissible within the framework of 35 U. S. C. § 103 to pick and choose from any one reference only so much of it as will support a given position (i.e., the conductive track in Gilmartin), to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art (i.e., the oxidase enzyme in the conductive track in Gilmartin). Thus, so long as the claims of this application require at least one enzyme to be a dehydrogenase enzyme, the combination of Hughes et al. and Gilmartin fails to render claims 1, 3, 10, 12, 13, and 15 obvious to one of ordinary skill in the art.


These differences cause Gilmartin to fail to remedy the deficiencies of Hughes et al. For these reasons, it is submitted the combination of Hughes et al. and Gilmartin fails to render claim 1, as amended, obvious to one of ordinary skill in the art. Claims 3, 10, 12, 13, and 15 depend either directly or indirectly from claim 1, as amended. Accordingly, the combination of Hughes et al. and Gilmartin fails to render claims 1, as amended, 3, 10, 12, 13, and 15 obvious to one of ordinary skill in the art.

In view of the foregoing, it is submitted that claims 1, 3, 5-16, 18, and 20-28, as amended, are in condition for allowance, and official Notice of Allowance is respectfully requested.

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